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IN THE

Supreme Court of the United States

OCTOBER TERM, 1977

No. 77-203

EDWARD S. IRONS,

Petitioner,

v.

COMMISSIONER OF PATENTS,

Respondent.

PETITIONER'S REPLY MEMORANDUM IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

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The opposition to the present petition is deceptive in its effort to paint an untrue picture of the issues presented. Pointedly,

> (1) It is *not* correct that "Petitioner contends (Pet. 2) that the Freedom of Information Act overrides the requirement in 35 U.S.C. (Supp. V) 122 that patent applications 'be kept in confidence'" (Opp. 2). This is a clear distortion of both 35 U.S.C. 122 *and* petitioner's "contention".
>
> Petitioner contends, *rather*, that 35 U.S.C. 122 itself *requires* that any and all "information concerning" applications for patents be made publicly avail-

able when "necessary to carry out the provisions of any Act of Congress".[1]

Since the Freedom of Information Act (FOIA) *is* an "Act of Congress" *prima facie* requiring public availability of *all* materials covered by 5 U.S.C. 552 (a) (2) (A), (B) and (C), the alternative secrecy provision of 35 U.S.C. 122, applying where *no* "Act of Congress" intervenes, is irrelevant. *This* issue has been raised *only* in the courts below.[2] It is of overriding interest to the proper administration of the patent system and should be determined in this Court *now*, because of its importance and because it was wrongly decided below.

2. Respondent's suggestion that the district court's tainted finding—based on suspect *ex parte* representations of the Patent Office on which the same court refused to permit petitioner to cross-examine or to obtain discovery needed for rebuttal—that docket cards are not used as an index *by the Patent Office*,

[1] 35 U.S.C. 122 provides:

"Confidential status of applications

Applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner. (Amended January 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949.)"

This statute has been in effect since 1952 and was amended in 1975 only to change "Patent Office" to "Patent and Trademark Office" to reflect a change in name.

[2] Respondent is *wrong* insofar as its cleverly worded note 4 (Opp. 3) suggests *this* question was ever posed or decided in *Sears* v. *Gottschalk*, 502 F.2d 122 (4 Cir. 1975). *In fact*, the issue posed there had nothing to do with any part of 5 U.S.C. 552 (a)(2) or availability of the *decisions* defined therein, but related *only* to availability of abandoned patent application files under 5 U.S.C. 552(a)(*3*).

is irrelevant. Moreover, it is *not true* that the docket cards were "not within the scope of petitioner's request for indices of decisions" (Opp. 3). The district judge himself held that a docket card "is a master card regarding each and every event in the course of processing a patent application" (Pet. 17a)—hence, such a card necessarily affords a way to pinpoint and locate particular events in the processing, such as decisions covered by 5 U.S.C. 552(a) (2). An "index" within the meaning of 5 U.S.C. 552(a) (2) is *anything* that will aid in locating the records in issue.[3] Petitioner indisputably requested access to *all* indices, including the docket cards. What really happened below is that to avoid holding the Patent Office in contempt, both inferior courts resorted to the intellectual dishonesty that what plainly *is* an index in its substance, form and style, is not to be called an index because the Patent Office expediently does not itself make "index" use of the material.

3. The district court *did* hold that insofar as any of the *decisions in issue* may be "statements of policy and interpretations" within 5 U.S.C. 552(a) (2) (B) or "instructions to staff that affect a member of the public" within 5 U.S.C. 552(a) (2) (C) they need not be produced. It did so *without* receiving any evidence as to their nature *on the record* and based solely on its law clerk's surreptitious *ex parte* consultation with the Patent Office, wherein *decisions* were treated entirely separately[4] from 5 U.S.C. 552(a) (2) (B)

[3] See *Wellford* v. *Hardin*, 315 F.Supp. 768 (D.D.C. 1970); Davies, "The Information Act: A Preliminary Analysis", 34 U. Chicago L. Rev. 761, 782-3 (1967). The latter states that an "index" under the FOIA is "any classification system that helps find a paper in a mass of files."

[4] The district court's opinion devotes the bulk of two pages (Pet. 22a-23a) to "decisions" and then states "The Court has *also* gone on to investigate 5 U.S.C. § 552(a)(2)(B) and (C) material, and

and (C) materials. This treatment was expedient and in the teeth of petitioner's *properly raised*[5] Rule 70 motion based on the failure of the Patent Office to obey the district court's 1970 order to index all decisions within 5 U.S.C. 552(a)(2), *Irons* v. *Schuyler*, 321 F.Supp. 628 (D.D.C. 1970). Moreover, the district court arrived at these conclusions *ex parte* without affording (and indeed while affirmatively precluding) opportunity for cross-examination or rebuttal based solely on respondent's self-serving, off-the-record representations first made known to petitioner, as a *fait accompli*, in the district court's decision (Pet. 12a-24a). Such a course of action is not countenanced by law—and respondent's effort (Opp. 4) to play on the *labels* "policy statements, staff manuals . . ." in lieu of addressing the problem, which is the lower courts' holding that Patent Office *decisions* are different from and *do not constitute* "policy statements . . .", as defined in 5 U.S.C. 552 (a)(2)(B) and (C) is, to say the least, unworthy.

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found that there are no statements of policy, staff manuals or staff instructions that are not only available to the public" (Pet. 23a; emphasis added). But the motion related *only to decisions* containing or amounting to "statements of policy and interpretation" and "staff instructions", *not* to *other materials* collected by the agency under the stated labels. By thus focussing on something other than decisions, the district court found an excuse to allow respondent's deliberate disobedience of the 1970 order to pass by.

[5] The failure to comply with the unappealed and hence final 1970 decree was properly raised at *any* time under F.R. Civ. P. 70. The effort to associate this matter with the "earlier appeal and remand" (Opp. 4) and to denominate it "not properly before the court" is inconsistent with the record facts.

The court of appeals, moreover, compounded *this* district court error by incorrectly asserting that the order in question which was *never* appealed was "affirmed by this court [of appeals]" (Pet. 3a). Petitioner's request for correction of the latter *material* error (Pet. 32) in the appellate decision was then summarily, and erroneously, denied.

4. The assertion that "petitioner suffered no prejudice" (Pet. 4) as a result of the *off-the-record*, surreptitious and clandestine November 30, 1973 meetings between the district judge's law clerk and the respondent's representatives is ludicrous on the face of the record. Petitioner has consistently asserted and still maintains that, given the right to cross-examine and rebut the representations made at those meetings, it *could* show gross factual errors in the district court findings. Moreover, the district court ruled *against* petitioner on alleged "facts" the latter was never permitted to meet or rebut, adduced *ex parte* between respondent and the district court. If that is *not* "prejudice", what is?[6]

5. Careful examination of the factual errors in the appellate opinion shows them to be clearly material. In particular, the *prima facie* false assertion first made by the district court that a *one-time only* destruction of docket cards was "routine" is obviously a calculated effort to make the respondent's *deliberate destruction* of an important object of petitioner's FOIA request appear harmless and constitutes a *serious* error of fact in the court of appeals' opinion, contrary to Opp. 5, n. 6. See Pet. 31a, pt. 1(b).

Similarly, the appellate court's *misstatement* of petitioner's ground for its motion to vacate below—see numbered point 2 at Pet. 31a-32a—is not a matter of argument but in the teeth of what the *motion says*. Moreover, the court of appeals *a fortiori* lacked jurisdiction to draw "inferences" (Opp. 5) contrary to the face of the petitioner's motion and appears to have done so in a misguided, improper effort to whitewash the irregularities of the district court proceeding.

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[6] The district court's self-serving "no prejudice" (Opp. 4) ruling is manifestly baseless, as is its erroneous affirmance below.

The other fact errors of the appellate opinion (Pet. 32a-33a; pts. 3-6) will obviously prejudice petitioner on remand, *are material* and *should* have been corrected.

Respectfully submitted,

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